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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,721	01/24/2001	Tatsuhiko Ikuta	1614.1115	3663
21171	7590	05/15/2007	EXAMINER	
STAAS & HALSEY LLP			KHATTAR, RAJESH	
SUITE 700			ART UNIT	PAPER NUMBER
1201 NEW YORK AVENUE, N.W.			3693	
WASHINGTON, DC 20005			MAIL DATE	DELIVERY MODE
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/767,721	IKUTA, TATSUHIKO
	Examiner	Art Unit
	Rajesh Khattar	3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 02 March 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Acknowledgements***

The examiner for this application has changed. Please indicate Examiner Rajesh Khattar as the examiner of record in all future correspondence. This Office Action is in response to Applicant's response filed on March 2, 2007.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 2, 2007 has been entered.

### ***Status of Claims***

Claims 1-7, 9-11 and 13 have been amended. New claim 14 has been added. Claims 1-14 are pending in this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michel et al, U.S. Patent #5625690, in view of Lampson et al, U.S. Patent Application

Publication #20030194094. The examiner would like to point out that while Michel may not employ the same terminology as the present Applicants, Michel does teach the same ideas as Applicants. Specifically, Michel teaches the idea of certificating although it is couched in terms of a "software ID number" and "DES key" that is described in Michel at Column 4. The process of Michel then goes on to teach of a paying-per-use system in which security is enhanced by reference to a "counter" to determine if continued use of the software is allowed. This is equivalent to Applicants' licensing system without continual referral to an accounting server. What seems to not be expressly taught in Michel are some of the newer features of software that have been developed and in use since the publication of Michel. These features are the notions of certificate and license technologies. However, Lampson discloses these features, and so a combination of the references teaches the present invention as claimed.

**With regard to Claims 1 & 2,** Michel teaches the system and method comprising:

reporting, via a computer, identification to an accounting server from a terminal device, when contents to be charged for are accessed in the terminal device, and which is previously identified in said accounting server; (Col. 4, lines 7-13 and 55-59, describing a software identification number )

confirming propriety of the reported identification in said accounting server, and performing fee charging; and (Col. 4, line 64 – Col. 5, line 3, describing confirming identifying information; Col. 8, lines 24-32, describing fee charging)

when the propriety of the registration certification is confirmed, reporting permission of access to the contents, from said accounting server to said terminal device, and making the contents accessible in said terminal device, wherein , (Col. 5, lines 4-29 describing a public/private key system for accessing contents) wherein:

As mentioned above Michel, does not expressly teach certificates and licenses. However, these aspects of the invention are taught by Lampson at (Lampson,

paragraph 93, and Figures 9,11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, Col. 8, lines 24-32). Thus a combination of the references teaches:

when access is made to the contents, a license file in the terminal device is referred to, and, when the license file is determined to be valid, access to the contents is continued without accessing the accounting server, and

when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued.

Further, it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to combine the teaching of Michel related to usage tracking software with the teachings of Lampson, related to using certificates and licenses in an effort to provide both security and usage tracking in software applications. The motivation for such a combination is within the general knowledge available to one of ordinary skill in the art, and is simply to provide the most up-to-date techniques for implementing software validation and security techniques in order to implement a fee charging system.

**With regard to Claims 3,6,10,** Michel teaches the method, device, and recording medium comprising:

determining, via a computer, whether or not a condition for accessing contents is satisfied, when the contents are accessed; and wherein

enabling access to the contents when the condition for accessing the contents is satisfied, and enabling access to the contents after performing fee charging when the condition for accessing the contents is not satisfied,

(Col. 8, lines 24-32 fee charging; Col. 4, line 64 – Col. 5, line 3; Col. 5, lines 4-29 describing a public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach licenses. However, this aspect of the invention is taught by Lampson at (Lampson, paragraph 93, and Figure 11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, Col. 8, lines 24-32). Thus a combination of the references teaches:

Wherein when access is made to the contents, a license file in the terminal device is referred to, and, when the license file is determined to be valid, access to the contents is continued without accessing the accounting server, and

when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued.

Further, it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to combine the teaching of Michel related to usage tracking software as it relates to access to the software with the teachings of Lampson, related to using licenses in an effort to provide both security and usage tracking in software applications. The motivation for such a combination is within the general knowledge available to one of ordinary skill in the art, and is simply to provide the most up-to-date techniques for implementing software validation and security techniques in order to implement a fee charging system.

**With regard to Claims 4,7,11,** Michel teaches the method, device, and recording medium comprising:

determining, via a computer, whether or not a condition for accessing contents is satisfied; reporting fee charging to an accounting server when the condition for accessing the contents is not satisfied; and updating from said accounting server the condition for accessing the contents into a condition such that the contents can be accessed, wherein,

(Col. 8, lines 24-32 fee charging; Col. 4, line 64 – Col. 5, line 3; Col. 5, lines 4-29 describing a public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach licenses. However, this aspect of the invention is taught by Lampson at (Lampson, paragraph 93, and Figure 11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, Col. 8, lines 24-32). Thus a combination of the references teaches:

when access is made to the contents, a license file in the terminal device is referred to, and, when the license file is determined to be valid, access to the contents is continued without accessing the accounting server, and

when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued.

Further, it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to combine the teaching of Michel related to usage tracking software as it relates to access to the software with the teachings of Lampson, related to using licenses in an effort to provide both security and usage tracking in software applications. The motivation for such a combination is within the general knowledge available to one of ordinary skill in the art, and is simply to provide the most up-to-date techniques for implementing software validation and security techniques in order to implement a fee charging system.

**With regard to Claims 8, 12,** Michel teaches the device and recording medium wherein:

said determining part, accounting reporting part and updating part are achieved on an operating system of a terminal device. (Col. 9-10, Claims 3-7)

**With regard to Claims 5,9,13,** Michel teaches the method, device, and recording medium comprising:

receiving, via a computer, information previously issued for registration of a terminal device, and determining whether or not the information is valid;  
(Col. 4, lines 7-13 and 55-59, describing a software identification number )

transmitting the determination result to said terminal device, generating information indicating that a condition for accessing contents is satisfied when the determination result is that the certificate is valid, and transmitting the generated information to said terminal device; and (Col. 4, line 64 – Col. 5, line 3; Col. 5, lines 4-29 describing a public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach licenses. However, this aspect of the invention is taught by Lampson at (Lampson, paragraph 93, and Figure 11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, Col. 8, lines 24-32). Thus a combination of the references teaches:

charging said terminal device, wherein when access is made to the contents, a license file in the terminal device is referred to, and, when the license file is determined to be valid, access to the contents is continued without accessing the accounting server, and

when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued.

Further, it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to combine the teaching of Michel related to usage tracking software with the teachings of Lampson, related to using certificates and licenses in an effort to provide both security and usage tracking in software applications. The motivation for such a combination is within the general knowledge available to one of ordinary skill in the art, and is simply to provide the most up-to-date techniques for implementing software validation and security techniques in order to implement a fee charging system.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection presented below. With regard to rejection under 35 U.S.C. 112, Examiner has withdrawn previously cited 35 U.S.C. 112 rejection

in view of Applicant's amendment. However, further examination has resulted in new 35 U.S.C. 112 and 101 rejections.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims fail to identify the corresponding structure of an apparatus. It is not clear what component makes up the system. For example, term such as a part reporting, a part confirming, a part reporting is vague. This renders the claim indefinite.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 6-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 6-9 are directed to an apparatus, however, there is no corresponding structure in the claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michel et. al, US Patent No. 5625690, in view of Lampson et al, US Patent Application No. 2003/0194094 and further in view of Loeb et al., US Patent No. 6,014,641.

Previously, claims 1-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Michel in view of Lampson. With regard to the new limitation presented as part of Applicant's amendment, neither Michel nor Lampson specifically teach that a new license file received from the accounting server is installed. Examiner has interpreted this limitation as an automatic renewal feature and is described by Loeb. Loeb discusses an automatic subscription renewal system where subscribers must not only agree to automatic 1-year subscription renewals, but also agree to charge payment for the renewals on the subscribers' credit card (col. 2, lines 25-40). Therefore, it would have been obvious for a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Michel and Lampson to include disclosure of Loeb. One would have been motivated to do so in order to maintain continuity of the subscription as illustrated by Loeb.

Claim 14 is similar in scope to claim 1 and is rejected on similar ground.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rajesh Khattar whose telephone number is 571-272-7981. The examiner works on a Flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RL  
May 9, 2007

Richard Weisberger  
Primary Examiner

5/10/07  
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